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TO: EXAMINER MICHAEL LYONS

FACSIMILE NO.: 1-703-872-9306

FROM: George M. Kaplan, Esq.

PAGES: 4 (including this page)

YOUR REF: Serial No. 09/996,239

OUR REF: 298-147

COMMENT:

Enclosed, please find a **REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**. Please confirm receipt of these documents by return facsimile. Thank you

Thank you.
George M. Kaplan

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Steinbichler et al.

Examiner: Lyons, Michael A.

Serial No.: 09/996,239

Group Art Unit: 2877

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Filed: November 28, 2001

Docket: 298-147

JAN 13 2004

For: PROCESS AND APPARATUS
FOR RECORDING THE
DEFORMATION...

Dated: January 13, 2004

OFFICIALCommissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**REQUEST FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION**

In accordance with M.P.E.P. §706.07(a), it is respectfully requested finality of the Office Action mailed December 5, 2003 by the Patent and Trademark Office be withdrawn, for the following reasons.

An Information Disclosure Statement was timely August 23, 2002, however the art cited therein was not made of record by the Patent and Trademark Office in the first Office Action mailed April 16, 2003. Accordingly, a copy of requisite Form PTO-1449 filed with the Information Disclosure Statement was included with the Amendment filed September 22, 2003.

CERTIFICATE OF FACSIMILE

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office (1-703-872-9306) on the date shown below.

Dated: January 13, 2004
George M. Kaplan

The Office Action mailed December 5, 2003 states, in Conclusion on page 5 thereof.

Applicant's submission of an information disclosure statement under 37 CFR 1.97(e) with the fee set forth in 37 CFR 1.17(p) on September 22, 2003 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i) [underlining emphasis added]

However, this Information Disclosure Statement was not submitted September 22, 2003 with a fee, but rather filed August 23, 2002, well in advance of mailing of the first Office Action on April 16, 2003.

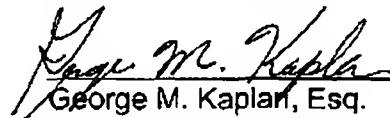
M.P.E.P. §706.07(a) reads, in pertinent part, as follows:

Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the Examiner may use the information submitted, . . . and make the next Office action final whether or not the claims have been amended . . . [emphasis added]

In the present instance, however, the art being applied against the claims was cited before issuance of the first Office Action, not thereafter and not with a fee. All previous grounds for rejection have been withdrawn in the Office Action mailed December 5, 2003, with the only grounds for rejection being a reference (U.S. Pat. No. 5,467,184 to Tenjimbayashi) cited in the Information Disclosure Statement filed August 23, 2002.

Accordingly, it is respectfully submitted finality of the Office Action mailed December 5, 2003 should be withdrawn as improper, to allow Applicants full opportunity to respond to the rejection raised therein on the merits with the response period also being appropriately reset to run from mailing of the non-final Office Action.

Respectfully submitted,



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